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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,320	01/22/2000	TONY PELED	1194/7	6181

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EXAMINER

BELYAVSKIY, MICHAIL A

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/463,320	Applicant(s) PELED ET AL.	
	Examiner Michail A Belyavskiy	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7-13,15,37,39,42-45 and 47-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-13,15,37,39,42-45 and 47-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO APPLICANT'S AMENDMENT

1. Applicant's amendment, filed 04/22/04 is acknowledged.

Claims 1-2, 4-5, 7-13,15, 37, 39, 42-45 and 47-57 are pending and under consideration in the instant application.

In view of the amendment, filed 04/22/04 the following rejection remains:

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-2, 4-5, 7-13,15, 37, 39, 42-45 and 47-57 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al(Blood Cells, 1994, v.20, pages 468-481) or C.De Bruyn et al., (Stem Cells 1995, v.13, pages 281-288) each in view of Percival et al (J Nutrition, 1992, v122 pages 2424-2429) for the same reasons set forth in the previous Office Action, mailed 02/04/2004.

Applicant's arguments, filed 04/22/04 have been fully considered, but have not been found convincing.

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Applicant asserts that: (i) there has been a long-felt but unsolved need for methods that permit *ex vivo* expansion of hematopoietic cells and the combination of either of the primary references, Moore or DeBruyn with Percival has not lead the ordinarily skilled artisan to the solution of long-felt need for a methods that permit *ex vivo* expansion of hematopoietic cells; (ii) the combination of either of the primary references with secondary references is improper hindsight; (iii) neither Moore nor De Bruyn teach or suggest reducing the capacity of the hematopoietic cells in utilizing copper to inhibit differentiation during ex-vivo expansion using a transition metal chelator such as TEPA; (iv). Percival et al., does not cure the fatal deficiencies of Moore and De Bruyan since Percival et al., does not say that TEPA inhibits differentiation; (v) Delcaration under 37 C.F.R. by Dr. Fibach states that Percival does not teach or suggest culturing conditions using define growth medium conditions that will stimulate growth while inhibiting differentiation. Percival et al., references teaches away from combination with the primary references.

Applicant is respectfully reminded that the rejection under 35 USC103 does not set any specific time frame when the attempts to combine the references should be made.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re McLaughlin , 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). See MPEP 2145.

Contrary to Applicant's assertion it appears that applicant and the examiner differ on interpretation of both the claimed methods and the prior art. Also, applicant relies upon an asserted and claimed mechanism of action but does not provide objective evidence how the prior art teaching of the same culturing condition using the same step and the same reagent differs from the claimed methods. It is unclear how the method taught by Percival et al. using a step of providing hematopoietic cells with TEPA differ from the claimed method. Therefore, it is clear that both Percival et al. and applicant administer the same reagent, that is TEPA to hematopoietic cells to achieve the same results. It is acknowledged that applicant now recites and believes in a different mechanism of action than the prior art. However, the instant methods do not negate or preclude the mechanism of action indicated by the prior art nor does applicant provide objective evidence to distinguish the prior art from the claimed invention. Moreover, the mechanism of action does not have a bearing on the patentability of the invention if the invention was already known or obvious. Even though applicant has proposed or claimed the mechanism by which TEPA acted on hematopoietic cells, it does not appear to distinguish the prior art teaching the same or nearly the same methods to achieve the same end result. Mere recognition of latent properties in the prior art does not render

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nonobvious an otherwise known invention. In re Wiseman, 201 USPQ 658 (CCPA 1979). Granting a patent on the discovery of an unknown but inherent function would remove from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art. In re Baxter Travenol Labs, 21 USPQ2d 1281 (Fed. Cir. 1991). See M.P.E.P. 2145. However, Applicant cited the second publication of Percival et al, wherein it is clearly stated that "if copper is essential for differentiation then chelation of copper with TEPA should prevent the cell from differentiation".

Clearly one skill in the art would be aware of the fact that a transition metal chelator TEPA might be used to inhibit differentiation.

Thus in contrast to applicant's assertions the disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. A prior art reference may be considered to teach away when "a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." See In re Gurley, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). See MPEP 2123.

Applicants have traversed the primary and the secondary references pointing to the differences between the claims and the disclosure in each reference. Applicant is respectfully reminded that the rejection is under 35 USC103 and that unobviousness cannot be established by attacking the references individually when the rejection is based on the combination of the references. see In re Keller, 642 F.2d 4B, 208 USPQ 871, 882 (CCPA 1981) See MPEP 2145. This applicant has not done, but rather argues the references individually and not their combination. One cannot show non-obviousness by attacking references individually where the rejections are based on a combination of references. In re Young 403 F.2d 759, 150 USPQ 725 (CCPA 1968). The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. In re Semaker. 217 USPQ 1, 5 - 6 (Fed. Cir. 1983). See MPEP 2144.

Moore et al. teach a method of hematopoietic cell transplantation and method of adoptive immunotherapy, comprising obtaining hematopoietic cells from a donor, ex-vivo expansion of said cells and transplanting said cells to a patient (see, entire document, abstract in particular). Moore et al. teach that the hematopoietic stem cells can be derived from umbilical cord blood (see page 469 in particular). Moore et al. teach a growth medium with nutrients and early and late acting cytokines (See Material and Methods in particular). Moore et al. teach that ex vivo expansion of cord blood CD34+/CD38- cells will permit improved engraftment of adults (see abstract in particular).

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Similarly, C.De Bruyn et al. teach a method of hematopoietic cell transplantation and method of adoptive immunotherapy, comprising obtaining CD34⁺ hematopoietic cells from a donor, ex-vivo expansion of said cells and transplanting said cells to a patient (see, entire document, abstract in particular) C.De Bruyn et al. teach that the hematopoietic stem cells can be derived from umbilical cord blood or from bone marrow (see Page 282, in particular). Moore et al. teach a growth medium with nutrients and early and late acting cytokines (See Material and Methods in particular).

Moore et al. or C.De Bruyn et al. does not explicitly teach a method of hematopoietic cell transplantation and method of adoptive immunotherapy, under define growth conditions for cell proliferation and with a transition metal chelator , such as TEPA having an affinity for copper wherein said chelator inhibits differentiation of said cells.

Percival et al. teach culturing condition using define growth medium condition that will stimulate growth while inhibit differentiation. (see entire document, Abstract in particular). Percival et al. teach that cells can be made copper deficient by incubating them in the media containing 50 μ M TEPA (see Material and Methods in particular). Percival et al. teach that copper is essential for the process of differentiation and chelating copper with tetraethylenepentamine will inhibit differentiation (see page 2428 in particular).

Moreover, Applicant acknowledge that Percival et al. teach that cells can be made copper deficient by incubating them in the media containing tetraethylenepentamine without loss of viability or alteration in the stage of differentiation (see page 13 of Applicant's arguments, filed 06/11/03 , Paper No. 25 in particular). This supports the examiner position that TEPA support proliferation while inhibiting differentiation.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the teaching of Percival et al. to those of Moore et al. or C.De Bruyn et al. to obtain a claimed method of hematopoietic cell transplantation and method of adoptive immunotherapy, under define growth conditions for cell proliferation and with a transition metal chelator , such as TEPA having an affinity for copper wherein said chelator inhibits differentiation of said cells.

One of ordinary skill in the art at the time the invention was made would have been motivated to do so, because cultivating cells under growth conditions for reducing a capacity in utilizing copper using zinc containing medium or using a TEPA as a transition metal chelator having an affinity for copper will support only growth, proliferation and expansion without inducing differentiation of said cells will support only growth, proliferation and expansion without inducing differentiation of said cells as taught by Percival et al. that can be further used a method of hematopoietic cell transplantation and method of adoptive immunotherapy, comprising obtaining hematopoietic cells from a donor, ex-vivo expansion of said cells and transplanting said cells to a patient as taught by Moore et al. or C.De Bruyn et al.

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From the combined teaching of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Claim 52 - 57 are included because the claimed dosage of transition metal chelator from about 0.1 μ M to about 100mM, or from about 4 μ M to about 50 mM, from about 5 μ M to about 40 mM overlaps the referenced 50 μ M of TEPA and is therefore an obvious variation of the reference teaching absent a showing of unobvious property. Further, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F2d 454,456,105 USPQ 233; 235 (CCPA 1955). see MPEP § 2144.05 part II A.

4. No claim is allowed

5. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

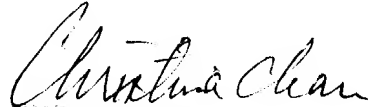
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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michail Belyavskiy whose telephone number is 571/272-0840. The examiner can normally be reached Monday through Friday from 9:00 AM to 5:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571/272-0841.

The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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June 28, 2004


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